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ROPES & GRAY LLP			PARRA, OMAR S	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/810,324	<b>Applicant(s)</b> SCHEIN ET AL.
	<b>Examiner</b> OMAR PARRA	<b>Art Unit</b> 2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 29 January 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date: 01/29/2010

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/29/2010 has been entered.

##### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 and 19 have been considered but are moot in view of the new ground(s) of rejection.

##### ***Priority***

After going through Provisional Applications 60/022826 and 60/015648 filed on July 26<sup>th</sup>, 1996 and April 19<sup>th</sup>, 1996, respectively, the examiner was not able to find support for the argued and newly added limitation: “*search, over the public network, at least one information database to identify data that (1) is related to a program corresponding to the selected television program title selected ...*” and “*wherein the data comprises search results obtained from the at least one information database*”.

Provisional 60/015648 discloses "an interactive television schedule system which can access television schedule information from the internet, and provide user access to the internet", page 2 lines 9-12. Provisional 60/015648 teaches:

"In a preferred embodiment, memory 14 of cable system 10 stores the software 16 needed for receiving, organizing, and displaying any received data into a television schedule guide. In addition to software 16, data for the basic schedule information and other related data (e.g., data relating to a particular show) are also stored in memory 14 as they are needed for the generation and maintenance of the television schedule guide. These data are received, in the preferred embodiment, via a cable modem 18, which may access the data from the internet. Software 16 then utilizes the data received from cable modem 18 to generate a television schedule guide. The user can retrieve this generated television schedule guide when desired", page 3.

"In one embodiment, cable modem 18 provides access to a database, which may be on-line; the database contains the television schedule information, and the information is transmitted to the television. Software 16 stored in memory 14 is used to search for and provide the information, along with providing several other features described below", page 4.

"The available data, displayed on the television, can emulate what a computer on-line user normally sees when accessing the internet through a personal computer. This television schedule data can also be further enhanced to "tie into" the televisions show that the user is viewing. The database containing the television schedule information may be stored in memory 14 within cable system 10, or within a database 48 within television 22. A controller 52 is used to obtain the data from memory 14 or from database 48 to display it on television 22. From the television schedule guide, the user can further utilize user interface 40 to press a "Services" button. This Services button can be located on the user interface or within the television schedule guide display. When the Services button is pressed, the user is given choices such as News, Weather, Sports, Scores, Financial Data, Local Traffic, Network, etc. Using the user interface, the user can then select the area or title of interest, and the associated information from the database is provided", pages 4 and 5

As shown above, Provisional 60/015648 discloses that the program information and information related to television show is downloaded and stored on the receiving device from a database on the internet; and not after selection of a title through user interaction. Even if there was user interaction, for the purpose of argument only, the

search for the related data is performed on a single database and not on a plurality or entire internet as argued and amended by the applicant.

Provisional 60/022826 teaches, among other things, a system that permits user selection on a program guide and user request for program related information on the internet. However, the search of the program related information is performed on a single database. The search of the additional content is always referred as a search performed on a or the remote database (page 1 lines 8-14; page 2 line 37-page 3 line 4; page 7 last paragraph-page 8 line 14; page 18 last paragraph-page 19 line 9; pages 20-22).

As shown, Provisional 60/022826 does not disclose searching for additional content related to a program over the internet, on at least one information database (which implies multiple databases), but searching on a database that is remotely located on the internet.

Therefore, the examiner respectfully believes that the newly added and argued limitation is not part of the disclosure of both provisional applications and therefore, the priority claimed over them, July 26<sup>th</sup>, 1996 and April 19<sup>th</sup>, 1996, is inappropriate.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-4, 15-22 and 33-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al. (hereinafter 'Matthews', Pub. No. 2004/0139465) in view of Shoff et al. (hereinafter 'Shoff', Pub. No. 2005/0015815) in further view of Legall et al. (hereinafter 'Legall', Patent No. 6,005,565, which was submitted by applicant on the IDS filed on 04/06/2006).

Regarding claims 1, 19, 38 and 39, Matthews teaches an interactive guide having a display screen comprising:

a program guide database for storing television schedule information including television program titles (**40, 46, 54 and 86, Fig. 3**);

a display controller (**Processor 92, Fig.4**) electrically coupled to the program guide database for displaying some of the television schedule information including television program titles on the display screen (**[#0063] lines 1-7**);

an input device (**[#0066] lines 5-8**) that is configured to:

receive a first user selection of a television program title displayed on the display (**[#0066] lines 1-5 or selection of 'Seinfeld', Fig. 5**); and

receive a second user selection requesting that data available on a public network and related to the selected television program title be displayed (**[#0069]-**

**[0072], where the user clicks on a hyperlink to get additional information related to a title;**

a processor (**processor 92, which controls all the elements of the client**) configured to search the public network to identify data that is related to a program (**when a hyperlink is clicked, the client, through the modem and processor, contact the ISP server to retrieve and present the related data; [0059]-[0060]; [0072]**) corresponding to the selected television program title (**When a click on a hyperlink is performed, the supplemental content requested is related to that single program title, [0054]; [0060]**) and that includes at least one item available for purchase(**[0054]; where available merchandise or memorabilia is present**) a communication device for receiving the identified data related to the selected television program title (**100, Fig. 4; [0061]**); and

a controller for displaying, in direct response to the second user selection, the received data related to the program corresponding to the selected television program title (**processor 92, Fig. 4, controls all the applications needed to render content from the ISP provider, EPG server, etc; [0063]**).

On the other hand, although Matthews teaches a communication device for receiving the identified data related to the selected television program title (**100, Fig. 4; [0061]**), Matthews does not explicitly teach downloading the data identified in the search and wherein the displayed data comprises a selectable option for purchasing the at least one item available for purchase.

However, in an analogous art, Shoff teaches a system that is capable of retrieving additional content related to a single title from internet when requested ([0016]-[0019]; [0050]-[0051]; [0068]). Shoff teaches that the additional content is downloaded onto the client device along with instructions or layouts on how to be displayed on the screen (at least at [0019]). The additional content can be items related to the program that can be navigated through a user interface (buttons 232-236, Fig. 8c; [0074]-[0076]; [0079]-[0080]), which gives the user a selectable option for purchasing the item (Order button 237).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Matthews' invention with the selectable option for purchasing as taught by Shoff for the benefit of not having the user to call or go to a store to buy the presented additional content.

Additionally, Matthews and Shoff do not explicitly teach searching over at least one information database and wherein the data comprise search results obtained from the at least one information database.

However, in an analogous art, Legall teaches a system that provides an integrated search tool for specifying and searching a variety of information resources (at least Abstract and col. 1 lines 29-43). The user is able to search for additional information throughout available on the internet about a program on an EPG (Jumanji presented on the EPG, Fig. 3B, col. 3 line 28-65). The results are shown in a list from all the searched sources (215, Fig. 2, col. 2 line 37-col. 3 line 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matthews and Shoff's invention with Legall's feature of searching additional information over at least one database on the Internet for the benefit of giving all or mostly all the information available to the user.

Regarding claims 2 and 20, the combined teachings of Matthews, Shoff and Legall teach an interactive program guide wherein the database resides on one or more remote file servers accessible through a communication link (**Matthews: 40, 46, 54 and 86, Fig. 3 connected to user through 74 and 82**).

Regarding claims 3 and 21, the combined teachings of Matthews, Shoff and Legall teach an interactive program guide wherein the communication link comprises the Internet (**Matthews: [0059]; [0072]**).

Regarding claims 4 and 22, the combined teachings of Matthews, Shoff and Legall teach an interactive program guide wherein the identified data comprises an advertisement (**Matthews: [0054]**).

Regarding claims 15 and 33, the combined teachings of Matthews, Shoff and Legall teach an interactive program guide wherein:  
the processor (**Matthews: processor 92, Fig. 4**) is further configured to:

display preview programming for a future-scheduled television program ([0063], where 'The Single Guy' is displayed on Fig. 5, which is preview programming to 'Seinfeld' which is a future-scheduled television program); identify a plurality of sources of information having data related to the future-scheduled television program ([0077]); select an identified source of information having data related to the future-scheduled television program (**Any of the shown hyperlinks can be selected individually, [0069]**); the communication device is further configured to establishing a link to the identified source of information (**100, Fig. 4; [0061]**); and the controller is further configured to display data from the linked source of information on the screen (**processor 92, Fig. 4, controls all the applications needed to render content from the ISP provider, EPG server, etc; [0063]**).

Regarding claims 16 and 35, the combined teachings of Matthews, Shoff and Legall teach wherein the data related to the future-scheduled television program comprises one or more of an advertisement, a video preview, and textual information ([0054]; [0067] or Entire Fig. 5).

Regarding claims 17 and 36, the combined teachings of Matthews, Shoff and Legall teach wherein the processor is further configured to store and display advertisement data ([0054]; [0056] lines 1-4 and 9-12).

Regarding claims 18, 34 and 37, the combined teachings of Matthews, Shoff and Legall teach wherein the identified data comprises one or more of television program actors, actresses, themes, other broadcast times, other broadcast sources, and associated available products (**[0054]; Actor -inherently, actress also-; associated available products -'trekiecollectables.html', Fig. 2**).

Regarding claims 40 and 41, Matthews, Shoff and Legall wherein the processor is further configured to search, over the public network, a plurality of information databases, wherein the plurality of information databases are accessed on at least two different sources (**Legall: as seen on Fig. 3B, 341 permits to search all the WEB and multiple WEB engines can be used; col. 1 lines 29-43**).

5. Claims **5-14 and 23-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al. (hereinafter 'Matthews', Pub. No. 2004/0139465) in view of Shoff et al. (hereinafter 'Shoff', Pub. No. 2005/0015815) in view of Legall et al. (hereinafter 'Legall', Patent No. 6,005,565, which was submitted by applicant on the IDS filed on 04/06/2006) and further in view of Herz et al. (hereinafter 'Herz', Patent No. 5,758,257).

Regarding claims 5 and 23, Matthews, Shoff and Legall teach all the limitations of the claims they depend on. On the other hand, they do not explicitly teach wherein the processor is further configured to:

monitor and store a plurality of user selections of television programs; learn a user preference based on the plurality of user selections of television programs; and activate the program guide based on the user.

However, in an analogous art, Herz teaches monitoring and storing the user selections of televisions programs (**col.14, lines 3-7; col. 25 lines 37-41**) to learn a user preference based on plurality of user selections of television programs (**col. 6 lines 50-57**) and activating the program guide based on the user preference (**col.23 lines 1-7**).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention to have modified Matthews, Shoff and Legall's invention with the monitoring, storing of user program selections for a further user customization of the program guide and content as taught by Herz for the benefit of presenting content or merchandise that fits the user and increase the chance of having the user consuming the content or purchasing the merchandise.

Regarding claims 6 and 24, wherein the processor is further configured to store the user preference responsive to a user input (**Herz, Co1.22, lines 19-65**).

Regarding claims 7 and 25, wherein the user preference comprises a television program (**Herz, col.25 lines 16-18**).

Regarding claims 8 and 26, wherein the user preference comprises a theme for a plurality of television programs (**Herz, Col. 4, lines 32-34**).

Regarding claims 9 and 27, wherein the processor is further configured to remind a user to view a preferred television program (**Herz: Col.23, lines 1-7**).

Regarding claims 10 and 28 , wherein the processor is further configured to record\_a preferred television program (**a record is kept of all movies or shows watched by all customers, Col. 1, lines 50-55 and Col.38, lines 42-43**).

Regarding claims 11 and 29, wherein the processor is further configured to download a copy of a preferred television program to a digital storage medium (**memory; Col.51, lines 40-52**).

Regarding claims 12 and 30, wherein the processor is further configured to:  
search the television schedule information (**Herz, Col. 5, lines 54-58**);  
identify television programs matching the theme for the plurality of television programs (**Herz, Col. 6, lines 1-35**); and  
record the television programs matching the theme for the plurality of television programs (**Herz, Col. 25, lines 15-30**).

Regarding claims 13 and 31, wherein the processor is further configured to:

search the television schedule information (**Herz, Col. 5, lines 54-58**);  
identify television programs matching the theme for the plurality of television  
programs (**Herz, Col. 6, lines 1-35**); and  
download a copy of the television programs matching the theme for the plurality  
of television programs to a digital storage medium (**Herz, Col. 25, lines 15-30**).

Regarding claims 14 and 32, wherein processor is further configured to adapt the television schedule information displayed on the screen based on the user preference (**Herz, Col.45, line 14-38**).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

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